

Applicants	:	Butts, <i>et al.</i>
Appl. No.	:	10/614,537
Examiner	:	Hussein A. El Chanti
Docket No.	:	700693-4022

REMARKS

Claims 1-29 are pending in the present application.

Claims 1-21 have been rejected under 35 U.S.C. §101 because the claimed invention is directed to non-statutory subject matter.

Claims 1-4 and 6-29 have been rejected as being anticipated by U.S. Patent No. 6,574,239 to Dowling *et al.* (“Dowling”).

Claim 5 has been rejected under 35 U.S.C. §103(a) as being unpatentable over Dowling.

Claims 1 and 10 have been amended.

It is respectfully submitted that no new matter has been added.

Reconsideration of the application as amended herein is respectfully requested.

CLAIM REJECTIONS

Rejections under 35 U.S.C. §101

The Office Action has rejected claims 1-21 under 35 U.S.C. §101 because the claimed invention is directed to non-statutory subject matter. Applicant respectfully traverses this rejection. Claims 1-21 are rejected as **computer programs** per se, i.e., the descriptions or expressions of the programs. The Office Action further stated that such programs are not physical “device or structure” nor are they statutory processes, as they are not “acts” being performed. 3/24/08, Office Action, p2. Claim 1, as amended, requires “[a] **co-verification interface adapted to interface with either a physical system element or a virtual system element and implemented in a design verification system.**” To qualify as a §101 statutory process, the claim should positively recite the other statutory class (the thing or product) to which it is tied, for example by identifying the apparatus that accomplishes the method steps.

Applicants	:	Butts, <i>et al.</i>
Appl. No.	:	10/614,537
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Docket No.	:	700693-4022

5/15/08 Memo to U.S. patent examiners from Deputy Commissioner for Patent Examination Policy, John J. Love with subject, “Clarification of “Processes” under 35 U.S.C. §101”. Since the claims require that the co-verification interface be implemented in a design verification system and coupled to the first system element and the communication system, Applicant respectfully submits that claim 1 and claims 2-20 which depend from claim 1 are qualified as §101 statutory processes. Note that this amendment is fully supported by the specification of the present application, which states that “[e]ach layer 610, 620, 630, 640 in the protocol stack 650 can be **implemented in hardware, software, or a combination of hardware and software components.**” ¶ [0035], specification, emphasis added.

Similarly, claim 21 has been amended to require “[a] **co-verification interface implemented in a design verification system comprising a physical system element and a virtual system element,**” and is rendered qualified as a §101 statutory process for the reason discussed above. Thus, Applicant respectfully submits that claim 21 is qualified as a statutory process under 35 U.S.C. §101.

Rejections under 35 U.S.C. §102(b)

The Office Action has rejected claims 1-4 and 6-29 under 35 U.S.C. §102(b) as being anticipated by Dowling. Applicant respectfully traverses this rejection.

Dowling discloses a method for reconnecting a telephone modem with a reduced delay by reducing a time associated with retraining. After a connection is terminated and then reestablished, the trained set of parameters for the connection is used to reconnect the model with a reduced set-up delay. See Dowling, Abstract. Dowling further discloses that the invention

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Appl. No.	:	10/614,537
Examiner	:	Hussein A. El Chanti
Docket No.	:	700693-4022

relates generally to client-server computing architectures and communication techniques. See Dowling, Col. 1, lines 7-8.

There are several fundamental differences between Dowling and the claimed subject matter. First of all, Dowling's system is directed to "a communication system including the remote unit and the virtual session server to support virtual sessions communications." See Dowling, Col. 3, lines 52-55. In contrast, claim 1 as amended requires "[a] **co-verification interface ... implemented in a design verification system.**" Emphasis added. Dowling's communication system is not a "design verification" nor can a teaching or suggestion to verify user's design be found therein. To anticipate a claim, the reference must teach every element of the claim. MPEP 2131. Since Dowling does not this feature of claim 1 requiring "[a] **co-verification interface ... implemented in a design verification system,**" Applicants respectfully submit claim 1 is not anticipated under 35 U.S.C. §102(b) by Dowling.

Furthermore, claim 1 as amended requires a "**co-verification interface that interfaces with either a physical system element or a virtual system element.**" This feature of claim 1 is neither taught nor suggested by Dowling. In fact, Dowling describes a communication system that only interfaces with a physical system element such as a remote unit or a server. See Dowling, Col. 3, lines 36-55. Therefore, Applicant respectfully submits that claim 1 not anticipated under 35 U.S.C. §102(b) by Dowling.

In addition, Dowling discloses that "a first protocol stack with an application session layer software module 151 communicates with a second protocol stack with an applications session layer software module 152." See Dowling, Col. 8, lines 36-39. Dowling further discloses that "the virtual session layer software module 154 communicates with a peer-to-peer

Applicants : Butts, *et al.*
Appl. No. : 10/614,537
Examiner : Hussein A. El Chanti
Docket No. : 700693-4022

communication path 182.” Col. 8, lines 56-59. Therefore, Dowling teaches that there are several communication channels (180, 182 and 184, Figure 2, Dowling) between the first system element (left side of Figure 1A) and the second system element (right side of Figure 1A).

In contrast, claim 1 as amended requires that “a physical layer ... [is] configured to **communicate with a second system element of the design verification system only via the communication system**.” Emphasis added. This feature of claim 1 is neither taught nor suggested by Dowling, therefore, Applicant respectfully submits that claim 1 not anticipated under 35 U.S.C. §102(b) by Dowling.

Claims 2-20 depend from and carry the limitations of claim 1, therefore claims 2-20 are not anticipated by under 35 U.S.C. §102(b) by Dowling.

Claim 21, as amended, requires that “**the physical system element and the virtual system element communicate only via the physical layer**.” Emphasis added. This requirement of claim 21 is neither taught nor suggested by Dowling for the reason discussed above, therefore Applicants respectfully submit that claim 21 is not anticipated under 35 U.S.C. §102(b) by Dowling.

Claims 22-29 have similar limitations as claims 1-21 as the Office Action admitted (3/24/08, Office Action, page 8), therefore Applicants respectfully submit that claims 22-29 are not anticipated under 35 U.S.C. §102(b) by Dowling for the reason discussed above.

Rejections under 35 U.S.C. §103(a)

The Office Action has rejected claim 5 under 35 U.S.C. §103(a) as being unpatentable over Dowling. Applicants respectfully traverse this rejection.

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Appl. No.	:	10/614,537
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Docket No.	:	700693-4022

In rejecting claim 5, the Examiner stated that “Dowling does not explicitly teach that the standard coupling interface comprises an Open Core Protocol. Official notice is taken that it would have been obvious for one of ordinary skill in the art at the time of the invention to implement open core protocol in Dowling’s interface.” 3/24/08, Office Action, page 9.

Whether or not one of ordinary skill in the art is motivated to implement Open Core Protocol in Dowling’s invention, claim 5 is not anticipated by Dowling because claim 1, from which claim 5 depends, is allowable over Dowling for the reasons discussed above. Therefore Applicants respectfully submit that claim 5 is patentable under 35 U.S.C. §103(a) over Dowling.

CONCLUSION

In view of the foregoing, it is believed that all claims now pending (1) are in proper form, (2) are neither obvious nor anticipated by the relied upon art of record, and (3) are in condition for allowance. A Notice of Allowance is earnestly solicited at the earliest possible date. If the Examiner believes that a telephone conference would be useful in moving the application forward to allowance, the Examiner is encouraged to contact the undersigned at (650) 614-7660. If there are any additional charges, please charge Deposit Account No. 15-0665.

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Appl. No.	:	10/614,537
Examiner	:	Hussein A. El Chanti
Docket No.	:	700693-4022

Respectfully submitted,

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